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Misc Ltr.

PATENT
7284/52829-R

Cooper
10-25-a

Not For Filing; Request For Interview
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
By Fax (703) 305-0285

Applicant	:	David G. Bird
Serial No.	:	08/862,039
Filed	:	May 22, 1997
For	:	LOCATION OF MISSING VEHICLES
Group	:	3662
Examiner	:	Theodore Blum

For Reissue of Original Patent
No. 5,418,537

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October 20, 2000

REMARKS

Assistant Commissioner for Patents
Washington, D.C. 20231

This is further to the voice mail message I left you today. I am transmitting herewith a passage from MPEP §1412.02. The passage marked A indicates that where reissue claims include a material, narrowing limitation not present in the claims deliberately canceled from the application for the original patent, there is no improper recapture.

Our contention is that our new reissue claims avoid recapture because they include a "material, narrowing limitation not present in the claims deliberately canceled from the application for the original patent."

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I will be in Washington next Tuesday, October 24, and would like to interview you in your office at about 11:00 a.m., if that is convenient.

Respectfully submitted,

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DSD:lo

newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would not be grounds for prohibiting a claim to that embodiment in the reissue.

§ 1412.02 Recapture of Canceled Subject Matter

A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1989); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363–64 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960). The Federal Circuit stated the following principles in *Clement*:

> (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

131 F.3d at 1469–70, 45 USPQ2d at 1165. See MPEP § 1412.03 as to broadening claims.

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17.

¶ *14.17 Rejection, 35 U.S.C. 251, Recapture*

Claim [1] rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in Ball Corp. v. United States, 221 USPQ 289, 295 (Fed. Cir. 1984):

"The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application." [2]

Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists. See MPEP § 1412.02

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). This is not to be considered a recapture. The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex Parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) or in canceling claims directed to this statutory category of invention must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex Parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat.